

Remarks

The Examiner has required that the Applicants elect one of the following groups of claims:

Group I, claims 1-4, 7, 8-9, and 12, directed to antibodies, hybridomas, kits, and other compositions; and

Group II, claim 10, directed to a method of producing antibodies.

The Examiner found that there is no unity of invention because, according to the Examiner, the inventions these claims define are not linked by a special technical feature. Under 37 C.F.R. § 1.475, a special technical feature is one that defines a contribution an invention makes over the prior art. The Examiner focused on an antibody to G3BP that binds residues 1-144 of G3BP and found that such an antibody is no improvement over the prior art. The Applicants respectfully disagree.

The Examiner found the G3BP antibody obvious in light of the Parker reference when considered in combination with the Schaffhausen reference. Parker discloses the amino acid sequence of the G3BP protein; Schaffhausen discloses a method of preparing antibodies to synthetic peptides. The references, whether considered alone or in combination, do not teach, disclose, or suggest the antibodies of the invention.

A process cannot render a product obvious unless one could reasonably expect that the process would successfully yield the product. MPEP § 2143.02. Whether it would be obvious to try using the process is not the question; indeed, it would be improper to even consider it. Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81 (Fed. Cir. 1986) (construing earlier precedent as standing for the proposition that "'Obvious to try' is improper consideration in adjudicating obviousness issue.").

The method of Schaffhausen does not enable one to make the antibodies of the invention with a reasonable expectation of success. The method is unpredictable; there are many variables to select from it. It is important, for example, that the "investigator must choose a peptide sequence with the greatest chance of success in eliciting an immune response." At 361, ¶ 2. Moreover, "[t]here are several considerations in choosing a sequence." Id., ¶ 3. Hydrophilicity is one such consideration. Id. The sequence's secondary structure is another. Id. There is no reasonable expectation that, using the peptide of Parker and the process of

Schauffhausen, one could select among the several considerations required and successfully yield the antibodies of the invention.

The Applicants respectfully submit that, in light of the foregoing, the antibodies of the invention are not obvious, and therefore constitute the special technical feature the Examiner found lacking.

The Examiner held that the special technical feature does not link the claims because the claims of Group I are directed to compositions, and the claim of Group II are directed to a process of making the compositions. All of the claims relate in some way to the antibodies of the invention. The Applicants respectfully submit that there is therefore a technical relationship involving the special technical feature of the invention, creating the unity of invention that § 1.475 requires. For this reason, the Applicants respectfully request that the Examiner withdraw the finding of lack of unity.

Respectfully submitted,



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